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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/088,768 | 04/12/2002 | Kaneyoshi Kato | 2651 USOP | 2281 |

7590 12/15/2004

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EXAMINER

FEDOWITZ, MATTHEW L

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| ART UNIT | PAPER NUMBER |
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1623

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/088,768 | KATO ET AL. | |
| | Examiner | Art Unit | |
| | Matthew L. Fedowitz | 1623 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/15/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-23,25-30,32-34 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23,25,26,28-30,33 and 34 is/are rejected.
- 7) ☒ Claim(s) 17,18,23,25-27,30 and 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 17-23, 25-30, 32-34 and 37 are pending in this action.

Election/Restrictions

In response to the applicant's inquiry regarding clarification of the restriction requirement, the restriction from 28 November 2003 is in addition to the restriction included with the non-final office action issued on 20 February 2004. Applicant's election of Group II (claims 17-34 and 37), in applicant's remarks dated 15 July 2004, is noted.

Claim Objections

- I. Claims 19, 27 and 32 are objected for not being in correct Markush format. The proper format of a Markush claim is "A compound selected from the group consisting of." Appropriate action is requested.
- II. Claims 17, 23, 25, 26, 27, 30 and 32 are objected to because each of the claims omits the article before several of the nouns in the claims. According to Strunk and White, the indefinite article *a* and *an* refer to a general term and signal or introduce nouns (see page 90). For example, claim 17 states "Y⁵ is hydrogen atom, halogen atom." The claim should read, "Y⁵ is *a* hydrogen atom, halogen atom. " The aforementioned claims are missing several articles before the nouns. Appropriate action is requested.

Claim Rejections - 35 USC § 103

Applicant's arguments and amendments overcome the obviousness rejection for claims 17-23, 25-30, 32-34 and 37.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35 U.S. Code not included in this action can be found in a prior office action.

I. Applicant's arguments overcome the 35 U.S.C. § 112 first paragraph rejections for claims 17, 23 and 29.

II. Applicant's arguments in response to the office action issued on 20 February 2004 are deemed unpersuasive. Claims 23, 25 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant uses the phrase "optionally having substituents selected from the group consisting of halogen atom, hydroxy, amino and C₆₋₁₀ aryl" in claims 23 and 30; and, "optionally having substituents selected from the group consisting of halogen atom, hydroxy, amino and C₆₋₁₀ alkoxy and C₆₋₁₀ aryl" in claim 25. In this case, each of the aforementioned phrases raises the specter of ambiguity because it is unclear as to whether there can be none, one or some of the substituents when the term "and" is used with "optionally" when listing the substituents. If the term "optionally" were used in reference to one substituent then the ambiguity would not arise as in *Ex parte Cordova*, 10 USPQ2d 1949 (Bd. Pat. App. & Inter. 1989). However, when the term "optionally" is used in reference to multiple substituents then it is unclear as to what is claimed. MPEP 2173.05(h) III states, in regard to the use of the term "optionally," that "in the instance where the list of potential alternatives can vary and ambiguity arises, then it is proper to make a rejection under 35 U.S.C. 112."

In addition, claims 26, 28, 29, 33 and 34 also rejected because claims that depend from an indefinite claim are also indefinite. See *Ex parte Cordova*, 10 USPQ2d 1949 (Bd. Pat. App. & Inter. 1989).

III. Applicant's arguments overcome the second basis for the 35 U.S.C. § 112 second paragraph rejection in regard to 22 USPQ2d 1828.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Matthew L. Fedowitz whose telephone number is (571) 272-3105 and can be reached between 9am-5:30pm (EST) M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Mr. James O. Wilson, can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matthew L. Fedowitz, Pharm.D., J.D.
December 6, 2004



James O. Wilson
Supervisory Patent Examiner
Art Unit 1623